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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,978	11/16/2001	Yujiro Kajihara	501.32049RV1	7905

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EXAMINER

CLARK, JASMINE JHIHAN B

ART UNIT	PAPER NUMBER
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2815

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/987,978

Applicant(s)

KAJIHARA ET AL.

Examiner

Jasmine J. Clark

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/21/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 2/21/02 1/27/02 2/2/00 11/16/01 2/22/04
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Improper Broadening***

1. Claim 27 is rejected under 35 U.S.C. 251 as being broadened in a reissue application filed outside the two year statutory period. The instant reissue application, filed June 9, 1999, is a reissue of US Patent 5,637,913, which claims priority under 35 U.S.C. 120 to US Patent 5,378,656. US Patent 5,378,656 issued on January 3, 1995 almost four and half years before the filing of this reissue.

Claim 27 in the instant reissue are each broader than claim 1 of US Patent 5,378,656 in respect that claim 27 does not require the step of bonding the semiconductor chip to the chip mounting portion. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would not have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

While it is acknowledged that claiming subject matter that was not claimed in the original patent is not improper in and of itself, *In re Amos 21 USPQ2d 1271*, claims 15-36 in this reissue are clearly an attempt to broader claims of US Patent 5,378,656. This broadening is impermissible because it effectively undermines the purpose of the statute, 35 USC 251 fourth paragraph, which is to put the public on notice of any intent to broaden within two years after issuance of the patent.

***Recapture of Cancelled Subject matter***

2. Claims 15-26 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon

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which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. Applicants have broadened/omitted certain claim requirement surrendered during prosecution of the patent in reissue (US 5,637,913). A review of the prosecution of application No. 08/311,021, which matured into US Patent No. 5,637,913, reveals that, in response to the PTO's rejection of all the claims on February 6, 1995, Applicants amended claims and argues that the claimed invention discloses unique and novel arrangement of parts, for example, arrangements wherein said chip mounting portion is smaller than a semiconductor chip attached thereto, and is positioned under a substantially central portion of the semiconductor chip, wherein the semiconductor chip is fixed to the chip mounting portion by adhesive, and wherein the semiconductor chip is fixed to a part of each of the suspension leads by adhesive, and wherein the semiconductor chip is fixed to a part of each of the suspension leads by adhesive which is located under a peripheral portion of the semiconductor chip. Further, in response to

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the PTO's rejection of all the claims on May 14, 1996, Applicants amended the claims and argued the suspension leads and chip mounting portion of the lead frame are continuously formed in an area of the semiconductor chip to advantageously and instrumentally maximize the area of resin contact to the semiconductor chip.

Applicants' arguments that recapture does not apply because the claims are to a different invention involving the embodiment regarding proper placement/orientation of "burrs". This is not persuasive because the placement of the burrs are taught to be avoided in column 6, lines 32-42 and such a claim limitation does not constitute an different invention.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 15-27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 37-49 of U.S. Patent No. 09/328.910. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of claims 15-27 are substantially met in claims 37-49 of the Application 09/328.910.

This is a provisional obviousness-type double patenting rejection because conflicting claims have not in fact been patented.

#### ***Telephone Inquiry Contacts***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasmine J. Clark whose telephone number is (571) 272-1726. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Jose Dees on (571) 272-1569. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**JASMINE CLARK  
PRIMARY EXAMINER**

*Jasmine Clark*